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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,822	04/25/2000	Timothy A. Barton	2799CIP	9903

7590 03/13/2002

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EXAMINER

NORMAN, MARC E

ART UNIT	PAPER NUMBER
3744	

DATE MAILED: 03/13/2002

#7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/557,822	BARTON, TIMOTHY A.
Examiner	Art Unit	
Marc E. Norman	3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 November 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 4/25/00 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

In view of the attached Notice of Draftsperson's Patent Drawing Review (PTO 948), and in view of revised USPTO policies and procedures regarding drawings, a proposed drawing correction or corrected drawings are required to reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it is unclear from the claim language exactly how the claimed invention reduces errors in freight services and billing. The system is actually more directed to reducing user errors, since that is where the mistakes occur. The actual billing and services are correct in that they reflect accurately what the user has chosen. Any discrepancies are a result of user errors not system errors. Accordingly, the preamble of the claim should be amended to reflect this distinction. Claims 2, 3, and 6 are rejected since they depend from rejected claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al. in view of Danford-Klein et al. (U.S. Patent 6,061,667) and Laverly.

As per claim 1, Hunt et al. teaches a server computer 83 (including system processor 90); a distributed network 80 connected to the server; a user computer 106 connected to the network; a database (see column 5, line 25) on the server containing shipping information (see column 3, lines 7-23). Hunt et al. does not teach programs or software for displaying at least one accessorial service and requiring the user to address the accessorial service offered and to accept or decline the accessorial service.

First, it is noted that the various types of accessorial services listed are all common and well known in the art, as described by Danford-Klein et al. (see Table 1, columns 17-19). Further, note that the system of claim 1 does not perform any of the accessorial services, it merely presents these as options to a customer that the customer must expressly accept or decline. Accordingly, the listed accessorial services are, in effect, nonfunctional descriptive material. As a result, the patentable distinction of the claim cannot rely on the type or title of service. The system would perform the same no matter what the title of the service was. The only difference a particular service type would yield would be what the customer would think or expect. This is not a structural distinction. Further, the reason why this is done, by itself, does not lend patentable weight. What matters is what is done, not why. Other motivations could

exist to do similar things for other services, e.g. to increase earnings for the merchant by making a customer specifically decline or accept an extended warranty or a maintenance plan or even accessories for the product purchased prior to checking out.

Second, the notion of requiring a user to accept or decline an option is well known in the art of computer programming. Laverly, for example, teaches a system requiring user agreement before proceeding, and explicitly requiring the user to accept or decline the agreement (see page 1, 5th paragraph). The fact that the applicant applies this feature within the context of accessory services does not render it patentable over the prior art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply this accept/decline feature of Laverly to the system of Hunt et al. since the basic concept (i.e., requiring a user to accept or decline an agreement before proceeding) is well known in the art, and since applying this feature to the case of accessory services is simply a specific application of requiring a user to accept or decline information. The accept/decline feature, even though applied by applicant to a different type of information, does not in itself render the claim patentable over the prior art. Also, the fact that it is being applied in order to reduce errors in freight services and billing does not lend patentable weight, since this simply pertains to why the feature is applied, not what is actually done.

As per claims 2 and 6, official notice is taken that addressing information individually or in a list are both common in the art of GUI programming and would have been obvious design choices are to how to present the agreement information.

As per claim 3, Laverly further teaches the user not being permitted to proceed until the agreement has been addressed (see page 1, 5th paragraph).

Remarks

The examiner notes that the above rejections are in contrast with the agreement reached between the Examiner and the Applicant during the interview conducted on 6 November 2001. However, further examination (particularly related to the issue of requiring a user to accept or decline on-line information) necessitated this rejection. In view of the previous agreement, the Examiner wishes to apologize to the Applicant for any inconvenience that this new rejection might cause.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Menzies teaches a system wherein a consumer chooses or declines an extended warranty. Sonderegger (U.S. Patent 5,893,118); Peters et al. (U.S. Patent 5,893,098); Brandt et al. (U.S. Patent 5,892,905); Godin et al. (U.S. Patent 5,890,138); Koreeda (U.S. Patent 5,890,137); Weber (U.S. Patent 5,889,863); Vanechanos, Jr. (U.S. Patent 5,884,309); Cook (U.S. Patent 5,860,068); Cohen et al. (U.S. Patent 5,847,957); Montulli (U.S. Patent 5,826,242); Ogram (U.S. Patent 5,822,737); Teper et al. (U.S. Patent 5,815,665); Weber (U.S. Patent 5,787,400); Wesinger, Jr. et al. (U.S. Patent 5,778,367); Storey (U.S. Patent 5,774,870); Levine et al. (U.S. Patent 5,745,681); Chelliah et al. (U.S. Patent 5,710,887); Anderson et al. (U.S. Patent 5,706,442); Hogan (U.S. Patent 5,699,528); Shavit et al. (U.S. Patent 4,799,156) were all

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submitted by applicant in the parent case as being generally relevant to a freight billing and services systems.

Hasbani et al. (U.S. Patent 6,169,977); Roberts et al. (U.S. Patent 6,101,486); Boucher et al. (U.S. Patent 6,078,889); Barni et al. (U.S. Patent 6,064,981); Boucher et al. (U.S. Patent 6,018,725); Boucher et al. (U.S. Patent 6,012,065); Barns-Slavin et al. (U.S. Patent 5,995,950); Hahn-Carlson (U.S. Patent 5,910,896); Hunt et al. (U.S. Patent 5,835,716); Nicholls et al. (U.S. Patent 5,485,369); Leiseca et al. (U.S. Patent 5,253,165); Danford-Klein et al. (U.S. Patent 6,061,667); Danford-Klein et al. (U.S. Patent 6,047,271); Danford-Klein et al. (U.S. Patent 6,041,318); Tangkilisan (WO-200046718-A2); Creasy et al. (WO-200046728-A2); ABL TRANS DIAL; and Horowitz were all either cited or applied by the Examiner in the parent case. Reasons for citation are provided in the parent case.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
March 6, 2002

KYLE J. CHOI
PRIMARY EXAMINER

Art Unit 2163

Attachment for PTO-948 (Rev. 03/01, or earlier)

6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTO-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.